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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/068,542	02/06/2002	Bo. T. Claridge	5007260-2	8006

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EXAMINER	
O'CONNOR, GERALD J	
ART UNIT	**PAPER NUMBER**
3627	

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/068,542	Claridge et al.	
	Examiner	Art Unit	
	O'Connor	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *THREE* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *June 2, 2005 and September 14, 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 4-29* is/are pending in the application.

4a) Of the above claim(s) *14-28* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 4-13, and 29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *February 6, 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Preliminary Remarks

1. This Office action responds to the amendment filed by applicant on September 14, 2005 and to the arguments filed by applicant on June 2, 2005, both in reply to the previous Office action on the merits, mailed November 29, 2004.

2. The amendment of claims 1, 4-12, 21, 22, and 26, the cancellation of claims 2 and 3, and the addition of claim 29 by applicant, all in the reply filed September 14, 2005, are hereby acknowledged.

Election/Restriction

3. Newly presented (amended withdrawn) claims 21-27 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The invention defined by newly presented (amended withdrawn) claims 21-27 (Invention IV) is related to the invention defined by claims 1-13 and 29 (Invention I) as combination and subcombination. Inventions in this relationship are distinct if it can be shown that: (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, *and* (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In this case, the combination as claimed does not require the

particulars of the subcombination as claimed, because a system in accordance with Invention IV need not include any processor. The subcombination has separate utility, such as for making a contribution to an investment account of an investor at a time of making a purchase, wherein the investor has only a single investment account.

4. Since applicant has received an Office action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, newly presented claims (amended withdrawn) 21-27 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

5. Claims 14-20 and 28 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim. Election was indicated as constructively elected by original presentation for prosecution on the merits in the Office action mailed November 29, 2004.

Claim Rejections - 35 USC § 101

6. The following is a quotation of 35 U.S.C. 101:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1, 4-13, and 29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1, 4-13, and 29 are drawn to a method of producing a disembodied data structure. It has been held that such claims are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea without producing any "useful, concrete, and tangible result." *In re Warmerdam*, 33 F.3d 1354; 31 USPQ2d 1754 (Fed. Cir. 1994).

Claim Rejections - 35 USC § 112, Second Paragraph

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if the "identifying..." is intended to mean "*the* identifying further comprising:," or else some other additional identifying of some other information. Additionally,

it is unclear how the "first" and "second" investment choices would be the first and second choices, since they are actually the second and third investment choices claimed, respectively.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1, 4-13, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke (US 6,112,191), in view of Barton (US 6,164,533).

Burke discloses a method for effectuating an investment comprising the steps of: receiving, by a processor, a request to complete an on-demand investment transaction in response to an action by a purchaser at a point-of-sale location; identifying, by the processor, investment-preference information associated with the purchaser in response to receiving the request; and, causing, by the processor, funds relating to the investment amount to be transferred to an investment account. See, in particular, Figures 4A, 4B, and 4C. The disclosure of Burke, though, does not specifically teach that the investment-preference information includes any predetermined dollar investment amount for the on-demand investment, as the investment amount in the method of Burke is specified at the point-of-sale location at the time of the sale.

However, Barton discloses a similar method of investment, which method indeed includes that the investment-preference information includes a predetermined dollar investment amount for the on-demand investment. See, in particular, column 5, lines 44-50.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Burke so as to include in the investment-preference information a predetermined dollar investment amount for the on-demand investment, in accordance with the teachings of Barton, in order to assist a user in achieving a budgeted investment goal by suggesting a default investment amount for each purchase being made.

Regarding claim 4, the method of Burke further comprises the step of temporarily accumulating the on-demand investment request until a predetermined completion time. See, in particular, column 3, lines 4-13.

Regarding claims 5-8, Burke does not disclose any investment limit/maximum, thus does not disclose accommodating an investment limit/maximum by including an investment total and a predetermined investment limit in the investment-preference information and, if the on-demand investment request would cause the limit/maximum to be exceeded, avoiding exceeding the maximum by either canceling the on-demand investment request or rolling the on-demand investment request over to a secondary/alternate investment account. However, Barton discloses a similar method of investment, which method indeed includes contributing the on-demand investment request to an investment account having a limit/maximum (an IRA). See, in particular, column 5, lines 44-50. Since canceling a deposit or rolling it over to a secondary/alternative

account are self-evident and well known, hence obvious, steps to perform in order to avoid exceeding a limit/maximum of an investment account having a limit/maximum, such as an IRA, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Burke so as to invest in an account having an investment limit/maximum, in accordance with the teachings of Barton, and to accommodate the investment limit/maximum by not exceeding it, by including an investment total and a predetermined investment limit in the investment-preference information and, if the on-demand investment request would cause the limit/maximum to be exceeded, avoiding exceeding the maximum by either canceling the on-demand investment request or rolling the on-demand investment request over to a secondary or alternate investment account, as is self-evident and well known to do, in order to obey the law by complying with limits/maximums imposed on certain investment accounts, such as IRAs, by the law, and since so-doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 9-11, the method of Burke comprises associating a purchasing account with an investment account and using either the purchasing account or a source other than the purchasing account to contribute to the investment account. See, in particular, column 12, lines 11-16.

Regarding claim 12, the method of Burke includes receiving, from the purchaser at the point-of-sale location, a request to specify the dollar investment amount. Therefore, the combination described above with respect to claim 1 would inherently include the step of

receiving, from the purchaser at the point-of-sale location, a request to modify the predetermined dollar investment amount, since simply specifying an amount is equivalent to modifying a predetermined amount of zero to any non-zero amount.

Regarding claim 13, the method of Burke includes adding the investment amount to a transaction amount, during processing of a point-of-sale transaction. Therefore, the combination described above with respect to claim 1 would inherently include the step of adding the predetermined dollar investment amount to the transaction amount, during processing of the point-of-sale transaction.

Regarding claim 29, the method of Burke includes a first investment choice and a second investment choice and automatically contributes the investment to each account without regard to whether or not other attempts to other accounts failed.

Response to Arguments

12. Applicant's arguments filed June 2, 2005 have been fully considered but they are not persuasive.

13. Regarding the arguments concerning the rejection under 35 U.S.C. 101, note that a "processor," as claimed, can be merely a person or corporate/legal entity/organization, thus, is not necessarily any element of hardware/technology.

14. Regarding the argument that the amount of Barton is not "predetermined," the amount of Barton is indeed predetermined. Otherwise, the system would not know how much to transfer. The amount has to be *determined, before* it can be sent, thus the amount is *predetermined.*

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to the disclosure.

16. Applicant's amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is (571) 273-6787.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at (571) 272-6771.

Official replies to this Office action may be submitted by any ***one*** of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC
November 22, 2005

Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627